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1805-0001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket No. **1805-0001**

Application of: **Mark E. Sanders**

Group Art Unit: **2210**

Serial No. **10/039,717**

Examiner: **J. Chapman**

Filed: **January 3, 2002**

Title: **Concrete Slab Protector**

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APPLICANT'S REPLY TO THE EXAMINER'S ANSWER

This Reply Brief is being filed within two months of the mailing date (February 24, 2004) of the Examiner's Answer, and is therefore believed to be timely. No fees are believed to be due with this Reply, but the Commissioner is authorized to charge any fees that may be incurred to Deposit Account 13-0014.

Related Appeals

In response to the Examiner's comment, Applicant's original Appeal Brief did include the following statement: There are no related appeals or interferences for this application.

REPLY TO EXAMINER'S ARGUMENTS

The Examiner's Answer has failed to establish a prima facie case for obviousness of Applicant's claims 1-9. First, Applicant has not argued purpose and use to distinguish Applicant's claimed slab protector from the form liner of Scott. Applicant's discussion of "use" has only been in the context of explaining the structure of the panel described in the Scott patent in an effort to expose the error in interpretation of this reference. In particular, the purpose and use of the Scott device was explained in order to demonstrate that Scott does not describe any folds in the form liner, as required by Applicant's claims. Contrary to the Examiner's assertion, this is not a case in which Applicant is trying to distinguish an identical structure based simply on the difference in the way the structure is used. The structure of the Scott form liner is not identical or similar to Applicant's claimed slab protector.

The Examiner's Answer further fails to rebut Applicant's arguments because it still relies upon a faulty interpretation of the primary reference, the Scott Patent. For example, the Examiner states, "Scott clear [sic] shows bends (joint), folds (joint) and perforations; see columns 7 lines 25-65". Applicant's claims do not refer to perforations, so this reference is confusing. Moreover, the discussion of "perforations" in Scott concerns imbedding a perforated sheet within the liner to minimize temperature increases. (See, col. 7, lines 54-63). More importantly, the Scott Patent never refers to a fold in the form liner. (In fact, the only use of the term "fold" is in the description of FIG. 1, in which a corner of the liner is "folded back"). Moreover, the Scott Patent never refers to "a bend" formed in its liner. (The patent does refer to the elastomeric face of the liner as being able to "still stretch and bend and flex from detail and undercuts on set concrete". Col. 8, lines 1-3).

The Examiner has introduced "bend" and "fold" as synonyms of the term "joint" used in the Scott Patent, as evidenced by the Examiner's statement, "A joint may be a fold and the Scott patent does show the fold portion/joint connecting the primary to the overhang portion". As explained in detail in the Appeal Brief, the Scott Patent's use of the term "joint" is always in the context of

an "abutting joint" between individual liner panels placed side-by-side. The term "joint" in Scott is not used to define "a fold portion connecting said primary portion to said overhang portion at an angle", as required by Applicant's claim 1.

The Examiner's misunderstanding is further reflected in the statement, "Applicant further argues that the Scott reference does not describe any of the liner panels being connected in any way; neither do the claims". Claim 1 recites a primary portion, an overhang portion, and "a fold portion connecting said primary portion to said overhang portion". [Emphasis added]. Applicant's claim 1 precisely defines a physical connection between the two portions of the slab protector – i.e., the fold portion. This fold portion is further defined as including a fold line in dependent claim 3. On the other hand, the form liner in Scott is a single non-bent, non-folded sheet. Again, the Examiner seems to be confusing the abutting joint lines 50 between side-by-side liners 43-46 in FIG. 4, and the abutting joint lines 51 between side-by-side concrete panels 40, 41, with physical folds or bends.

The concluding paragraph in the Examiner's Answer is convoluted and unclear. As best understood, it appears that the Examiner is suggesting that a liner panel of Scott can be arbitrarily divided into three portions and that the middle one of the portions can be arbitrarily named the "joint or fold portion". This arbitrary division of the Scott panel still ignores Applicant's claim limitation that the fold portion joins the other two portions "at an angle configured so that said overhang portion substantially abuts the side of the slab when said primary portion is resting on the surface of the slab". Of course, arbitrarily adding this claim element to the Scott form panel would constitute impermissible hindsight reconstruction.

Conclusion

The Examiner continues to misconstrue the Scott Patent in maintaining the rejection of claims 1-9 of the present application. The Examiner's Answer is again based on a misunderstanding of the Scott Patent and the use of the term "joint" in that reference.

The Scott Patent fails to disclose every element of independent claim 1. Most importantly, the Scott Patent neither discloses nor contemplates a fold portion connecting a primary portion and an overhang portion at an angle to form the claimed slab protector. Moreover, the Scott Patent neither discloses nor suggests providing such a fold portion so that the overhang portion can abut the side of a poured slab while the primary portion is resting on the surface of the slab.

Consequently, the Examiner has failed to establish a prima facie case for obviousness with respect to any of the claims of the present application. It is requested that the final rejection of claims 1-9 be reversed and that this Board direct the Examiner to issue a Notice of Allowance with respect to these claims.

Respectfully submitted,



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